

## REMARKS

Claim 11 has been amended. No claims have been added or canceled. Therefore claims 1-20 remain pending in the application. Reconsideration is respectfully requested in view of the following remarks.

### Section 103(a) Rejection:

The Examiner rejected claims 1-3, 8, 12-15 and 20 under 35 U.S.C. § 103(a) as being unpatentable over Parcel Insurance Plan (www.pipinsure.com) (hereinafter “Pipinsure”) in view of Keuper (DE 44 46 203 A1) (hereinafter “Keuper”), claims 4, 6, 9 and 19 as being unpatentable over Pipinsure and Keuper and further in view of Kadaba et al. (U.S. Patent 6,285,916) (hereinafter “Kadaba”), claims 5, 7, 10 and 11 as being unpatentable over Pipinsure and Keuper and further in view of Official Notice, claim 16 as being unpatentable over Pipinsure and Keuper and further in view of eBay, claim 17 as being unpatentable over Pipinsure and Keuper and further in view of Chen et al. (U.S. Patent 5,504,674) (hereinafter “Chen”) and further in view of knowledge generally available to one having ordinary skill in the art, and claim 18 as being unpatentable over Pipinsure and Keuper and further in view of Kepler (U.S. Patent 5,347,845). Applicants respectfully traverse these rejections for at least the following reasons.

**In regard to claim 1, contrary to the Examiner’s assertion, the cited art fails to teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, receiving a request to insure the item being shipped from an origination to a final destination.** The Examiner cites page 8 of Pipinsure that includes a form to request a savings quote. Clearly, a request *for a savings quote* is not a request *to insure an item*. Pipinsure discloses a series of questions a user can answer to “request a free quote on your package insurance needs.” The questions pertain to general characteristics of a user’s shipping habits including *average* number of packages insured per day and *average* value per insured package. Thus, instead of a specific package, the form addresses packages in the aggregate. A request for a saving quote regarding

aggregated shipments over days or months cannot be considered a request to insure a particular item being shipped from an origination to a final destination. Additionally, a business typically provides a *quote* to help facilitate a customer's decision on whether to order a service or product. Thus, a *quote* is requested *before* a customer actually decides whether to request a given service or product. Furthermore, Pipinsure fails to disclose an origination or a final destination for a specific item. Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel, such as identification, filling date, beer grade, etc. Keuper has nothing to do with a request to insure an item. Thus, Pipinsure and Keuper, taken singly or in combination, fail to teach or suggest a request to insure an item being shipped from an origination to a final destination.

Further in regard to claim 1, the cited art also fails to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. The Examiner asserts Pipinsure discloses this limitation on page 1. However, page 1 of Pipinsure merely discloses a simple table of annual potential savings dependent on a declared package value and number of shipments per day. A *table of potential savings* is not the same as *searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item.* In fact, a table of potential savings on a web page is completely different than searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item. Thus, Pipinsure and Keuper, taken singly or in combination, fail to teach or suggest searching a database for a cost effective insurance, wherein the cost effective insurance provides a specified level of insurance coverage for the item

Further regarding claim 1, the cited art fails to teach or suggest generating a data file comprising at least item information and insurer information. The Examiner cites page 8 of Pipinsure that discloses a form to request a savings quote. As described above, the form includes text fields to allow a user to enter answers to questions pertaining to a user's aggregated shipping habits. However, a form on a web

page that allows users to request a savings quote is not the same as generating a data file comprising at least item information and insurer information. As discussed above, Pipinsure discloses a series of questions that pertain to general characteristics of a user's shipping habits including *average* number of packages insured per day and *average* value per insured package. However, *insurer information* is not disclosed in any of the questions presented in the savings quote form of Pipinsure. Moreover, Pipinsure makes no mention of generating any data file. The mere existence of a web form for requesting a saving quote regarding a user's aggregated shipping habits does not imply the generation of a file including specific item information and insurer information. Clearly, Pipinsure and Keuper, taken singly or in combination, fail to teach or suggest generating a data file comprising at least item information and insurer information.

**Additionally in regard to claim 1, the cited art fails to teach or suggest storing the data file, containing both item information and insurer information, in a memory device that accompanies the item.** The Examiner admits that Pipinsure fails to disclose this limitation and relies on Keuper to disclose storing the data file in a memory device that accompanies the item. As noted above, Keuper describes a barrel tag transponder that stores data pertaining to the contents of the barrel. Keuper describes on page 8, lines 3-11:

This problem is solved in the following manner: during (or after) the filling of the barrel, filling data, such as the filling date and identification concerning the type of fluid charged in such as the beer grade, the filling volume, a sequential filling number, etc. are transmitted from the transmitting/receiving device to the transponder and are there stored as data set in a poll able manner is [sic] such a way that the data even at a later point in time cannot only be read out elsewhere but can also be updated.

However, as shown above, the data stored in Keuper's barrel tag transponder pertains to a barrel's contents. **The data stored in Keuper's barrel tag transponder does not include insurer information.** In fact, information such as the filling data disclosed by Keuper has absolutely nothing to do with insurer information. Furthermore, as argued above, Pipinsure fails to teach or suggest a data file containing both item information and insurer information. Thus, neither Keuper nor Pipinsure, taken singly or in combination,

teach or suggest a method for arranging insurance for an item, wherein the method comprises, in part, storing the data file, containing item information and insurer information, in a memory device that accompanies the item.

To establish a *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974), MPEP 2143.03. As described above, the cited art does not teach or suggest all limitations of the currently pending claims.

**Furthermore, the Applicant asserts the Examiner has failed to provide a proper motivation to combine the teaching of Pipinsure with the teachings of Keuper.** Obviousness cannot be established by combining or modifying the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion or incentive to do so. *In re Bond*, 910 F. 2d 81, 834, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). The Examiner asserts: “One of ordinary skill would have found it obvious at the time of the invention to combine the teachings of Keuper with the teachings of Pipinsure with the motivation of acquiring shipment-handling data on an item.” However, Pipinsure teaches relying on the shipment carrier to maintain shipment-handling data for a particular item. For instance, Pipinsure teaches that prior to filing a claim with Pipinsure, a user should “[f]ile a tracer with the carrier without delay when a package is lost” and a copy of the carrier’s tracer form is a required document when filing a claim (Pipinsure, page 5). Thus, one of ordinary skill in the art would not be motivated to modify the teachings of Pipinsure to include the “keg tag” of Keuper to acquire shipment-handling data on an item because Pipinsure already utilizes a specific method of acquiring shipment-handling data – namely relying upon the independent shipping carriers to track shipments. One of ordinary skill in the art would simply use the teachings of Pipinsure to acquire shipment-handling data on an item.

Additionally, it would not make sense to modify Pipinsure to use the keg tags of Keuper. Since, as noted above, Pipinsure provides insurance for packages shipped using independent carriers, such as Airborne Express, DHL, FedEx, UPS, and the U.S. Postal

Service, among others. Thus, the packages being insured never actually pass through a Pipinsure facility. In order to use the keg tags of Keuper, Pipinsure would have to receive each item, attach Keuper keg tag, and then ship the package via the appropriate carrier. Clearly it does not make sense to modify Pipinsure as suggested by the Examiner.

Moreover, for at least the reasons given above, even if the references were combined, such a combination would not result in Applicant's claimed invention.

Thus, the rejection of claim 1 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 5, the cited art fails to teach or suggest the method of claim 1, further comprising forwarding copies of the data file via the network to one or more predetermined email addresses. Furthermore, the Examiner takes official notice that "it is old and well know within the computer arts to transmit information via a network to an email address" Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner's taking of official notice in the context of Applicant's claimed invention. Applicant asserts that it was not well known in the prior art to transmit copies of a data file including item information and insurer information via a network to one or more predetermined email addresses. In fact, as discussed above, neither Pipinsure nor Keuper, taken singly or in combination, disclose a generating a data file with item information and insurer information much less forwarding copies of that type of data file via the network to one or more predetermined email addresses. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, Pipinsure, Keuper, and the Examiner's Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 5.

Thus for at least the reasons presented above, the rejection of claim 5 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 6, the cited art fails to teach or suggest the method of claim 1 further comprising forwarding a copy of the data file via a network to a central server. The Examiner admits Pipinsure fails to disclose this limitation. The Examiner relies on Keuper and Kadaba to disclose forwarding a copy of the data file via a network to a central server. The Examiner cites Kadaba. Kadaba discloses (column 2, lines 30-54):

Generally described, the present invention provides an electronic parcel tracking system for use by an organization, comprising an intelligent hand-held, portable data entry and data processing device, which includes a wand-mounted symbol reader, a data entry and display screen capable of receiving and displaying information, including signature information, input by contact with the screen, an information storage device, a data transfer device, and a processor connected to the reader, the screen, the storage device, and the data transfer device. The processor is configured to associate and store in the information storage device data related to a particular parcel, including symbol information read by the reader, signature information acquired by the screen, and keyed information acquired by the screen, and to respond to queries about the particular parcel entered via the screen by displaying the data associated with the parcel.

Preferably, the data transfer device is selectively operable to transfer information from the information storage device to a personal computer system located at a parcel receiving location of the organization. Also, the portable data entry device may be equipped with a modem for transferring information related to a particular parcel between the information storage device and a central computer system located at a parcel delivery firm. (emphasis added)

Clearly, Kadaba fails to disclose, in the cited art or elsewhere, a data file comprising insurer information. Instead, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Furthermore, neither Pipinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a data file comprising insurer information. The Examiner's combination of cited art fails to teach or suggest forwarding a copy of the data file via a network to a central server, wherein the data file comprises insurer information.

Thus, for at least the reasons presented above, the rejection of claim 6 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 7, the cited art fails to teach or suggest the method of claim 1, further comprising further comprising shipping the item using the least expensive routing. Furthermore, the Examiner takes official notice that “it is old and well know within the shipping and parcel delivery arts to ship items using the least expensive routing.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of official notice in the context of Applicant’s claimed invention. Applicant asserts that it was not well known in the prior art to ship items using the least expensive routing *wherein the item is accompanied by a memory device that stores a data file containing at least item information and insurer information*. In fact, as discussed above, neither Pipinsure nor Keuper, taken singly or in combination, disclose shipping an item using the least expensive routing wherein the item is accompanied by a memory device that stores a data file containing insurer information. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, Pipinsure, Keuper, and the Examiner’s Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 7.

Thus for at least the reasons presented above, the rejection of claim 7 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 10, the cited art fails to teach or suggest the method of claim 1, wherein storing the data file comprises data in an XML format. Furthermore, the Examiner takes official notice that “it is old and well know within the computer arts to store data in eXtensible Markup Language (XML) format.” Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner’s taking of official notice in the context of Applicant’s claimed invention. Applicant asserts that it was not well known in the prior

art to store a data file that comprises data in an XML format *wherein the data file is stored in a memory device that accompanies an item*. In fact, as discussed above, neither Pipinsure nor Keuper, taken singly or in combination, discloses that storing the data file comprises data in an XML format *where the data file is stored in a memory device that accompanies an item and where the data file includes at least item information and insurer information*. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, Pipinsure, Keuper, and the Examiner's Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 10.

Thus for at least the reasons presented above, the rejection of claim 10 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 11, the cited art fails to teach or suggest the method of claim 9, wherein the network data is exchanged in an XML format. Furthermore, the Examiner takes official notice that "it is old and well know within the computer arts to exchange network data in an XML format." Pursuant to M.P.E.P. § 2144.03, Applicant traverses the Examiner's taking of official notice in the context of Applicant's claimed invention. Applicant asserts that it was not well known in the prior art to exchange data in an XML format on a network *wherein the data includes at least item information and insurer information*. In fact, as discussed above, neither Pipinsure nor Keuper, taken singly or in combination, discloses exchanging data including both item information and insurer information in an XML format on a network. Pursuant to M.P.E.P. § 2144.03 Applicant asserts that the examiner must provide documentary evidence in the next Office action if the rejection is to be maintained. See also 37 CFR 1.104(c)(2), (d)(2) and *In re Zurko*, 258 F.3d 1379, 1386 (Fed. Cir. 2001). Thus, Pipinsure, Keuper, and the Examiner's Official Notice, taken singly or in combination, fail to teach or suggest the specific limitations of claim 11.

Thus for at least the reasons presented above, the rejection of claim 11 is unsupported by the cited art and removal thereof is respectfully requested.

In regard to claim 19, Applicant asserts the rejection of claim 19 is unsupported by the cited art for at least reasons similar to those presented above in regard to claim 1. Furthermore, Applicant asserts neither Pipinsure, Keuper, nor Kadaba, taken singly or in combination, teach or suggest a server connected to the memory device, wherein the server is configured to receive a request to insure the item being shipped from an origination to a final destination, search a database for a cost effective insurance, wherein the cost effective insurance provides maximum insurance coverage for the item for the least cost, generate a data file comprising at least the following item information, and insurer information, and store the data file in the memory device that accompanies the item. The Examiner asserts "Claim 19 substantially repeats the same limitations as claims 1, 6, and 9 and therefore, is rejected for the same reasons given for claims 1, 6, 9 and incorporated herein." The Examiner has improperly ignored the specific differences between the claim limitations of claims 1 and 19. Neither claims 1, 6, nor 9 - referred to by the Examiner in the rejection of claim 19 - recite a server configured as recited in claim 19. Furthermore, claims 6 and 9 recite limitations that are very different than the limitations of claim 19.

Additionally the cited art also fails to teach or suggest providing maximum insurance coverage for an item for the least cost. For example, the cited art of Pipinsure discloses a web form a user may fill out to request a savings quote. The Examiner also cites Pipinsure's simple table of annual potential savings dependent on a declared package value and number of shipments per day. *A savings quote and a table of potential savings* have nothing to do with providing maximum insurance coverage for an item for the least cost as recited in claim 19. Furthermore, Keuper discloses a barrel tag transponder that stores data pertaining to the contents of the barrel. The cited art of Keuper has absolutely nothing to do with *insurance* much less providing maximum insurance coverage for an item for the least cost. Keuper and Pipinsure, taken singly or

in combination, fail to disclose providing maximum insurance coverage for an item for the least cost. Additionally, Kadaba teaches storing, in an information storage device, symbol information, signature information, and keyed information. Thus, Kadaba, like Keuper, is absolutely silent in regard to item *insurance* much less providing maximum insurance coverage for an item for the least cost. Kadaba, Keuper, and Pipinsure, taken singly or in combination, fail to disclose providing maximum insurance coverage for an item for the least cost.

Thus for at least the reasons presented above, the rejection of claim 19 is unsupported by the cited art and removal thereof is respectfully requested. Similar remarks as those above regarding claim 19 also apply to claim 20.

Applicants also assert that numerous ones of the dependent claims recite further distinctions over the cited art. However, since the rejections have been shown to be unsupported for the independent claims, a further discussion of the dependent claims is not necessary at this time.

## CONCLUSION

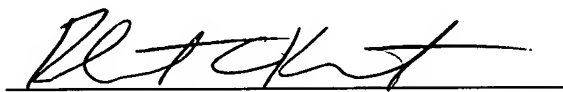
Applicants submit the application is in condition for allowance, and prompt notice to that effect is respectfully requested.

If any extension of time (under 37 C.F.R. § 1.136) is necessary to prevent the above-referenced application from becoming abandoned, Applicant hereby petitions for such an extension. If any fees are due, the Commissioner is authorized to charge said fees to Meyertons, Hood, Kivlin, Kowert, & Goetzel, P.C. Deposit Account No. 501505/5596-00901/RCK.

Also enclosed herewith are the following items:

- ☒ Return Receipt Postcard
- ☐ Petition for Extension of Time
- ☐ Notice of Change of Address
- ☐ Other:

Respectfully submitted,



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Date: October 17, 2006